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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,873	04/02/2004	Otto Machhammer	239016US0	1032
22850	7590	02/27/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/27/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/815,873

Applicant(s)

MACHHAMMER ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

***Final Rejection***

**The Status of Claims**

Claims 1-32 are pending.

Claims 1-32 have been rejected.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 1-14 and 17-32 under 35 U.S.C. 112, first paragraph, has been maintained due to applicants' failure to modify the claims in the amendment.

**Claim Rejections-35 USC 103**

1. Applicants' argument filed 11/29/06 have been fully considered but they are not persuasive.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**The rejection of Claims 1-32 under 35 U.S.C. 103(a) as being unpatentable over Ushikubo et al (U.S. 5,380,933) in view of Bogan et al (EP 1193240).**

The rejection of Claims 1-32 under 35 U.S.C. 103(a) as being unpatentable over Ushikubo et al (U.S. 5,380,933) in view of Bogan et al (EP 1193240) has been maintained for the reasons of the record on 8/28/06.

**Applicants' Argument**

2. Applicants argue the following issues:
  - a. Ushikubo et al suggests nothing that would inform the skilled artisan in the art that high pressure is beneficial in the reaction stage, or that any recycling of raw material would be beneficial, nor does it provide any hint of at which pressure the work-up of the product gas should be carried out or what the outlet pressure of the work-up product should be; similarly, Bogan et al is silent with regard to pressure during the purification or its outlet;

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- b. Regarding the rejection of Claims 1-14 and 17-32 under 35 U.S.C. 112, first paragraph, applicants have disclosed in the specification at page 9, lines 27-29 that useful catalysts for the claimed process are in principles all of those which are recommended in the prior art for the heterogeneously catalyzed partial direct oxidation of propane and/ or isobutane to at least one of the target products.

First, regarding the first applicant's argument, the Examiner has noted applicants' argument. However, as applicants have indicated that it is possible to conduct the reaction process under a slightly elevated pressure (see col. 5, lines 67-68) as described in Ushikubo et al ; also, Bogan et al expressly shows the reaction zone pressure of from 0 to 75 psig (see page 10, paragraph #0065). Furthermore, the control of either the inlet or outlet pressure of the reaction zone is within the purview of the skilled artisan in the art ; in addition, the limitation of the process with respect to the pressure ranges of the inlet or outlet pressure does not have impart any patentability to a process when such values are those which would be determined by one of the skilled artisan in the art in achieving optimum operation of the process. Also, any recycling of raw material is well-known in the art to make the process economical . Therefore, it would have been obvious to the skilled artisan in the art to control either the inlet or outlet pressure of the reaction zone so as to achieve the optimum operation of the process in the absence of an unexpected result.

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Second, regarding the second argument, the Examiner has noted applicants' argument. However, applicants have entitled to have a right to claim any protection of any solid catalyst on what is disclosed in the specification ; however, outside of its scope, applicants have no right on any solid catalyst unrelated to the claimed invention. After reviewing In re Wands, 8 USPQ2d 1400 (1988), factors :

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art

to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, the specification falls short because data essential for any solid state catalyst for the process for heterogeneously catalyzed partial oxidation of propane and /or isobutane to at least one of the target products acrylic acid, methacrylic acid is not described in the specification. Therefore, applicants' argument is irrelevant to the issues of the claimed invention.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Taylor Victor Oh, MSD, LAC  
Primary Examiner  
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